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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,971	07/07/2000	STEPHEN ROY PENNINGTON	60319-010	4635

26127 7590 08/10/2005

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EXAMINER

WESSENDORF, TERESA D

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/582,971

**Applicant(s)**

PENNINGTON, STEPHEN ROY

**Examiner**

T. D. Wessendorf

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 12-21 and 28-46 is/are pending in the application.
- 4a) Of the above claim(s) 12-16 and 32-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 17-21, 28-31 and 37-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Status of Claims***

Claims 1-9, 12-21 and 28-46 are pending

Claims 12-16 and 32-36 are withdrawn from further consideration.

Claims 1-9, 17-21, 28-31 and 37-46 are under examination.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 112, second paragraph***

Claims 1-9, 17-21, 28-31 and 37-46, as amended, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for reasons advanced in the last Office action 11/4/2004.

***Response to Arguments***

Applicants state that with the amendment to claim 1, the rejection under paragraph (A) has been obviated.

In reply, even with the claimed amendment "wherein the mixture of proteins contains the one or more proteins of interest", the rejection has not been overcome. The use of different terminologies e.g., "mixture of proteins" or one or more proteins"; "proteins of interests" provide for confusion as

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to which proteins is being referred to. Because there is no structure for any of the proteins to differentiate one from the other the terminologies are confusing.

B). and C). The rejection of the claims under these paragraphs had been obviated with the amendments to the claims.

***Claim Rejections - 35 USC § 102/35 USC § 103***

Claims 1-5, 17 and 28-29, as amended, are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nelson et al (US 2001/0019829) for reasons advanced in the last Office action.

***Response to Arguments***

Applicants argue that Nelson does not provide a means for creating an experimental tool. Nelson does not suggest the use of comparative mass spectrometry in order to identify various antibodies.

In response, applicants' arguments are not commensurate in scope with the claims. The claims do not recite for an experimental tool or the claimed steps of the experimental tool. Also, the comparative mass spectrometry is confusing. It is not clear as to which "one or more proteins" or "mixture of proteins" that is compared to step A. The use of inconsistent terminologies to mean the same thing(?) provides for confusion and ambiguity.

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Nevertheless, attention is drawn to the abstract of Nelson which recites said comparative mass spectrometry determination.

Applicants further argue that the instant method provides a method of "inverse screening" which allows for the screening and targeting of various proteins, either individually or in a mixture.

In reply, the argued termed "inverse screening" is not recited in scope of the claims. Hence, applicants' arguments are not commensurate in scope with the claims.

Claims 1-9, 17-21, 28-31 and 37-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson in view of Xu (2003/0157089) and Zsebo et al (6,759,215) for reasons advanced in the last Office action.

#### ***Response to Arguments***

The response under Nelson above is incorporated herein in view of applicants similarly incorporating their arguments herein.

Applicants argue that Xu does not suggest an "inverse screening" method as provided by the present invention nor the motivation to combine Xu with Nelson to obtain the claimed screening method. Xu is argued to disclose a flow-thorough or strip test assay used for the collection of various peptides or

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antibodies wherein such collective devices are well known in the art.

In reply, the term "inverse screening" is not commensurate in scope with the claims or does not state the steps included in said inverse screening.

Xu is further argued to use ficoll during centrifugation as opposed to the instant blocking reagent. Applicants state that through experimentation it was determined that the use of ficoll was a preferred blocking agent and resulted in enhancing the quality of results for the peptide mass fingerprinting data.

In reply, whether the ficoll is used for a different purpose is irrelevant. Xu uses Ficoll in the same method of mass spectrometry, albeit in centrifugation step, as opposed to applicants' discovery as a blocking agent using mass spectrometry experiment. The discovery of a new function for ficoll as used in mass spectrometry does not cause the method drawn to those things to distinguish over the prior art.

Applicants suggest that the use of formic acid as an eluting agent would not provide the motivation to combine the above-mentioned references.

In reply, Applicants fail to argue why one having ordinary skill in the art at the time the invention was made cannot use

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No claim is allowed.

**Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

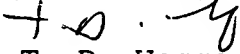
This application contains claims 12-16 and 32-36 drawn to nonelected invention. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. D. Wessendorf whose telephone number is (571) 272-0812. The examiner can normally be reached on Flexitime.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
T. D. Wessendorf  
Primary Examiner  
Art Unit 1639

tdw

August 3, 2005